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| SERIAL NUMBER | FILING DATE | FIRST NAMED APPLICANT | ATTORNEY DOCKET NO. |
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| 08/544,212 | 10/17/95 | RUSSO | D 01222.0034 |

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A1M1/0701

| EXAMINER | |
|-------------|--------------|
| BRUNSMAN, D | |
| ART UNIT | PAPER NUMBER |
| | 1108 |

DATE MAILED:

07/01/96

Please find below a communication from the EXAMINER in charge of this application.

Commissioner of Patents

A shortened statutory period for response to this action
is set to expire three months(s), or thirty days,
whichever is longer, from the date of this communication.

Office Action Summary

Application No.

08/544,212

Applicant(s)

Russo et al

Examiner

David M. Brunzman

Group Art Unit

1108



☒ Responsive to communication(s) filed on 18 Oct 1995

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-55 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-55 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 7

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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The reissue oath or declaration filed with this application is defective because it fails to particularly specify the errors and/or how the errors relied upon arose or occurred as required under 37 CFR 1.175(a)(5). Included are inadvertent errors in conduct, i.e., actions taken by the applicant, the attorney or others, before the original patent issued, which are alleged to be the cause of the actual errors in the patent. This includes how and when the errors in conduct arose or occurred, as well as how and when these errors were discovered. Applicant's attention is directed to *Hewlett-Packard v. Bausch & Lomb*, 11 USPQ2d 1750, 1758 (Fed. Cir. 1989). The oath or declaration fails to specify specifically *how* the errors occurred.

Claims 1-55 are rejected as being based upon a defective reissue declaration under 35 U.S.C. § 251. See 37 C.F.R. § 1.175.

Claims 28-55 are rejected under 35 U.S.C. § 251. These claims are rejected as not being "for the invention disclosed in the original patent," as evidenced by the claims in the original patent. *In re Rowland*, 187 USPQ 587. Reissue applicant's failure to timely file a divisional application is not considered to be an error causing a patent granted to be inoperable. See *In re Orita, Yohagi and Enomoti*, 193 USPQ 145 and *In re Mead*, 198 USPQ 412. If a reissue application presents claims to species not claimed in the original patent, the added claims may be rejected for lack of defect in the original patent and lack of error in obtaining the original patent. See MPEP §1450. The reissue claims must be drawn to the coating composition to which the patented claims were limited.

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Claims 28-55 are rejected under 35 U.S.C. § 251. The original application contained claims to a coating composition wherein the organometallic portion contained an organotin compound and an organosilicon compound. These claims were rejected as being unsupported by the original specification in that only certain species of organosilicon were enabled. In response to this rejection applicant limited the claims to compositions wherein the organosilicon compound was limited to the species recited in patented claim 1. The instant claims expand the scope of the invention to include any organometallic compound including those specifically included in the original rejection. "The recapture rule bars the patentee from acquiring, though reissue claims that are of the *same or broader scope* than those claims that were cancelled from the original application." *Ball Corp. v. United States*, 221 USPQ 289, 295; see also *In re Willingham*, 127 USPQ 211; *In re Richman*, 161 USPQ 359 and; *In re Wadlinger, Kerr and Rosinski*, 181 USPQ 826.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David M. Brunsman whose telephone number is (703) 308-0661.

DMB
June 28, 1996



David M. Brunsman
Primary Examiner
Group 1100